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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,539	12/03/2003	George W. McClurg	1823.0820003	3200
26111	7590	04/26/2005	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ROBINSON, MARK A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/725,539	Applicant(s) MCCLURG ET AL.	
	Examiner Mark A. Robinson	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4-7, 14 and 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/17/04</u> , <u>8/17/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I and the species of fig. 3 in the reply filed on 4/12/05 is acknowledged. The traversal is on the ground(s) that the "grouping of claims is inappropriate because dependent claims are grouped, and not separate independent claims."

However, the application does not contain an allowable linking claim as will be set forth below (note section 2 of the restriction requirement concerning "linking claims"). Therefore, patentability must necessarily be based on the separately claimed details of the separately grouped dependent claims.

The requirement is still deemed proper and is therefore made FINAL.

Applicant has stated that claims 2,3,8 and 11-13 read on the elected species of fig. 3. However, the radial sections coupled at predetermined angles as in claim 2 are shown in the non-elected species of figs. 12 and 13.

Accordingly, claims 1,3,8-13 and 15 read on the elected invention and will be examined as follows. The remaining claims

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are withdrawn from consideration as being drawn to non-elected subject matter.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spherical shape of claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin

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as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1,3,8-13 and 15 are objected to because of the following informalities: it appears that "at" is missing before "an" in line 5 of claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,3,11,13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Rachlin (US 4925300).

Rachlin shows a prism including a non-planar conical first portion(3) which is symmetrical about a central axis(4), and one of a non-planar or planar second portion (either 5 or 10) which

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is coupled at an angle to the first portion. Note that the first portion includes a target section and is "configured" to receive a body portion (a portion of the user's hand).

The preamble recitation of "used in a system..." is a statement of intended use which has not been given significant patentable weight since it does not further limit the present invention structurally.

6. Claims 1 and 9-13 and 15 are rejected under 35

U.S.C. 102(b) as being anticipated by Albada (US 2146662).

Albada shows a prism(2) including a non-planar spherical first portion (the curved surface) which is symmetrical about a central axis and a planar second portion (the flat surface) which is coupled at an angle to the first portion. Note regarding claims 9 and 10 that the material is glass. Note regarding claim 13 that the first portion includes a target section (the curved surface), but "configured to be used..." is a statement of intended use which does not further limit the present invention structurally.

The preamble recitation of "used in a system..." is a statement of intended use which has not been given significant patentable weight since it does not further limit the present invention structurally. Further, it should be noted that

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Albada's element(2) constitutes a prism in a similar manner as would applicant's element(108), especially when the first portion is spherical as set forth in claim 12.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rachlin in view of applicant's admission of the prior art.

Regarding claim 8, Rachlin does not teach the first portion to include a protective coating. However, such an arrangement is known as admitted by applicant on page 9 of the specification. It would have been obvious to the ordinarily skilled artisan at the time of invention to include a protective coating in Rachlin's device in order to provide the prism with protection.

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Regarding claims 9 and 10, Rachlin does not state what the prism is made of, although glass is taught in the background of the specification and is admitted to be known as an appropriate material by applicant on page 9 of the specification. Inasmuch as one of the claimed materials is not taught by Rachlin, it would have been obvious to the ordinarily skilled artisan at the time of invention to use such material (e.g. glass) for Rachlin's prism as a durable and readily available optical material.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Albada in view of applicant's admission of the prior art.

Regarding claim 8, Albada does not teach the first portion to include a protective coating. However, such an arrangement is known as admitted by applicant on page 9 of the specification. It would have been obvious to the ordinarily skilled artisan at the time of invention to include a protective coating in Albada's device in order to provide the prism with protection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Segall and Lindner both show prisms with angled non-planar and planar portions. Fishbine shows a prism for taking biometric data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

MR

4/21/05


MARK A. ROBINSON
PRIMARY EXAMINER